

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the PATENT application of

Ricky F. Combest

Application No.: 09/539,662

Filing Date: March 30, 2000

For: DYNAMIC VIRTUAL NETWORK
AND METHOD

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) Group Art Unit: 2141
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) Examiner: Kristie D. Shingles
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) Atty. Dkt.: 114944-00208
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APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is an Amended Appeal Brief. Please charge any fees, including fees for extension of time under 37 C.F.R. § 1.136(a), or credit any overpayment thereof, to Deposit Account No. 23-2185 (114944-00208). A duplicate copy of this sheet is attached.

Respectfully submitted,

By: _____

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AMENDED APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present Brief on Appeal is submitted further to the Notice of Appeal filed December 14, 2006, and in response to the Notification of Non-Compliant Appeal Brief mailed June 21, 2007. Any required fee, including any required fee for an extension of time, may be charged to Deposit Account No. 23-2185 (114944-00208).

I. Real Party in Interest

The real party in interest is the assignee, TC (Bermuda) License, Ltd., of Hamilton, Bermuda.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1-51 have been presented for examination. Claims 8-27 and 38-50 have been withdrawn from consideration. Claims 1-7, 28-47, and 51 are pending, stand finally rejected, and form the subject matter of the present appeal.

IV. Status of Amendments

The Response to Final Rejection filed on October 16, 2006, did not seek to amend the application.

V. Summary of the Claimed Subject Matter

The invention defined by claim 1 and the claims dependent therefrom is directed to a dynamic virtual network on which participating members can establish partnerships, communicate, and share information, the network comprising: a network authority including a computer programmed for network administration (Fig. 3, network authority 302; page 9, lines 3-4 and 16-32); at least a first network member and a second network member, each member including a computer comprising means for communicating over a global network (Fig. 3, businesses 304; page 9, lines 6-7); at least a first network access device and a second network access device, wherein the first access device is accessible by the first network member and the second access device is accessible by the second network member, each of the first network access device and the second network access device storing information about the corresponding

one of the first network member and the second network member such that the information is searchable by the other one of the first network member and the second network member (Fig. 3, business network access appliances 303; page 9, lines 8-10; page 10, line 28, through page 12, line 5); and for each network access device and the network authority, an interface facilitating connection to a global network (Fig. 3, communication links 209; page 9, line 5).

Claim 5 depends from claim 1 and adds the further limitation that the network authority further includes a means for contemporaneously archiving a communication transmitted over the network (Fig. 4, non-repudiable transaction manager 416; page 10, lines 24-26).

Claim 6 depends from claim 1 and adds the further limitation that each network access device includes a means for contemporaneously archiving a communication transmitted through the device (Fig. 5, non-repudiable transaction manager 544; page 16, lines 18-20).

The invention defined by claim 28 and the claims dependent therefrom is directed to a method for forming a partnership between two dynamic virtual network members connected by a network, the method comprising: selecting a partnership criterion by the first network member (Fig. 6, step 612; page 23, line 17); broadcasting the partnership criterion by the first network member to other network members (Fig. 6, step 622, page 23, lines 17-19); receiving by a second network member the partnership criterion; the second network member responding to the first network member (Fig. 6, steps 632, 634, and 636; page 23, lines 21-29); and establishing a partnership relationship between the first network member and second network member (Fig. 6, steps 614 and 624; page 23, line 31, through page 24, line 2).

The invention defined by claim 36 and the claims dependent therefrom is directed to a method for conducting a transaction between network members over the dynamic virtual network, the method comprising: transmitting and contemporaneously archiving information

from a first network member to a second network member (Fig. 8, steps 811, 821, 822, 831, and 832; page 26, lines 16-33); and receiving and contemporaneously archiving the transmitted information by the second network member (Fig. 8, steps 841 and 842; page 27, lines 1-3).

Claim 37 depends from claim 36 and adds the further limitation that a priority network transmission is carried by a commercial global network service which provides business critical levels of service (Fig. 3, business exchange network 300 and communication links 209; page 8, lines 2-3; page 9, lines 2-5).

Claim 45 depends from claim 44, which depends from claim 36, and relative to claim 36, adds the further limitations that transmitting and contemporaneously archiving includes encrypting the information and that encrypting the transmitted information includes exchanging public keys between the first and second network members (exchange of keys, page 26, lines 7-9).

Claim 46 depends from claim 36 and adds the further limitation that receiving and contemporaneously archiving transmitted information includes digitally signing a document by the second network member (application of personal digital certificate/signature and logging of the transaction in permanent storage, page 27, lines 10-17).

VI. Grounds of Rejection to be Reviewed on Appeal

1. The rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) over *Schneider et al* in view of *Weschler*.

2. The rejection of claims 28-36, 38-44, 47 and 51 under 35 U.S.C. § 103(a) over *Kleinpeter III et al* in view of *Schneider et al*.

3. The rejection of claims 5, 6, 37, 45 and 46 under 35 U.S.C. § 103(a) over *Schneider et al* and *Weschler* and further in view of *Kleinpeter III et al*.

VII. Argument

A. General Considerations

The Final Rejection dated June 14, 2006, has been carefully considered. In response thereto, the Appellant respectfully appeals from the rejection of claims 1-7, 28-47, and 51 under 35 U.S.C. § 103(a) and submits that the present claimed invention would not have been obvious over the combination of references asserted in the Final Rejection.

Before the specifics of the claims are discussed relative to the applied prior art, the Appellant wishes to note the following principles of law, which the Appellant wishes to apply to the discussion of each particular claim rejection.

First, with regard to a rejection under 35 U.S.C. § 103(a) over a combination of references, the mere fact that every element of the claimed invention can be found in the prior art does not suffice to show that the combination would have been obvious. *In re Rouffet*, F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Such a ground of rejection would constitute impermissible hindsight. *Id.* Also, the mere level of skill in the art does not amount to a teaching to combine. *Id.*, 47 U.S.P.Q.2d at 1458. Instead,

the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Id. The permissible sources for motivation are “the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *Id.*

Second, the Office is not at liberty to pick and choose which teachings it will apply from each reference. Instead, it is legally bound to consider “disclosures in the references that diverge from and teach away from the invention at hand.” *W. L. Gore & Associates, Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983).

Third, the mere fact that the prior art could have been modified in a certain way does not suffice to show that the modification would have been obvious. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Instead, the prior art must suggest the desirability of the modification. *Id.* That desirability must be shown “from positive, concrete evidence of record which justifies a combination of primary and secondary references.” *Id.*

With those legal principles in mind, the Appellant will now discuss the specifics of the rejection.

B. Specific grounds of rejection

1. Claims 1-4 and 7

The Appellant respectfully urges reversal of the rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) over *Schneider et al* in view of *Weschler*. Under the case law set forth above, it would not have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the references as proposed by the Office.

Schneider et al uses an access control database in which changes are propagated to all local copies. *Weschler* teaches an improvement on LDAP queries. There would have been no reason to incorporate the LDAP queries of *Weschler* into the access control database of *Schneider et al*, since the local copies would already have the updated information. Accordingly, the Appellant respectfully submits that the proposed combination of references would have been pointless and therefore non-obvious, and the prior art of record does not suggest the desirability of the modification, but instead teaches away from the modification.

Part A on pages 2-3 of the Final Rejection notes that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” However, the Appellant has made no such argument. Instead, the Appellant has

explained how the present claimed invention would not have been obvious over *the combinations* of references proposed by the Office.

Part A goes on to assert that the proposed combination “is obvious to protect the privacy and integrity of information stored on each user’s device.” However, what is obvious now is beside the point. What matters is what would have been obvious to “the skilled artisan .. *with no knowledge of the claimed invention....*” *Rouffet, supra*, 47 U.S.P.Q.2d at 1457. The Office has the burden of explaining why such an artisan would have selected the elements from the applied references. *Id.* There is no such showing in the Final Rejection.

For the reasons set forth above, the Appellant respectfully submits that the rejection is unfounded and should be reversed.

2. Claims 28-36, 38-44, 47 and 51

The Appellant further urges reversal of the rejection of claims 28-36, 38-44, 47 and 51 under 35 U.S.C. § 103(a) over *Kleinpeter III* in view of *Schneider et al.* Similarly to the arguments set forth above, the updating of the local copies in *Schneider et al* would have obviated the need for the agent server of *Kleinpeter III et al.* Accordingly, the Applicant respectfully submits that the combination of *Schneider et al* with *Kleinpeter III et al* would have been equally non-obvious.

Part B on pages 3-4 of the Final Rejection alleges that the Applicant’s arguments regarding teachings of the prior art that teach away from the combination “are unrelated to the claimed invention and irrelevant to the use of the references as prior art in the rejection of the above claims.” That argument is incorrect as a matter of law. It is well settled law that the Office is not at liberty to pick and choose which teachings it will apply from each reference.

Instead, it is legally bound to consider “disclosures in the references that diverge from and teach away from the invention at hand.” *Gore, supra*.

For the reasons set forth above, the Appellant respectfully submits that the rejection is unfounded and should be reversed.

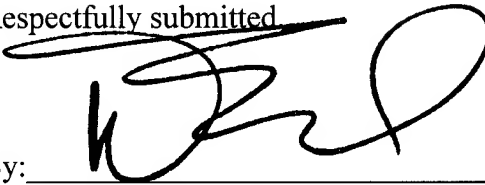
3. Claims 5, 6, 37, 45 and 46

Finally, the Applicant respectfully traverses the rejection of claims 5, 6, 37, 45 and 46 under 35 U.S.C. § 103(a) over *Schneider et al* in view of *Weschler* and further in view of *Kleinpeter III et al*. The combination of the three references suffers from the same deficiencies as both of the combinations of the two references discussed above. In other words, the combination of the three references does not overcome the above-noted deficiencies of either of the proposed combinations of the two references, with the consequence that the combination of the three references would not have taught or suggested the present claimed invention. Therefore, the Appellant respectfully submits that the rejection is unfounded and should be reversed.

For the reasons set forth above, the Appellant respectfully submits that the present claims define subject matter that would not have been obvious over the combination of references proposed in the Final Rejection. Therefore, the Appellant respectfully urges that all grounds of rejection set forth in the Final Rejection be reversed.

For all of the reasons set forth above, the Appellant respectfully urges reversal of the rejection of claims 1-7, 28-47, and 51.

Respectfully submitted



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VIII. Claims Appendix

The following is a list of the claims involved in the appeal in their current form.

1. A dynamic virtual network on which participating members can establish partnerships, communicate, and share information, the network comprising:

a network authority including a computer programmed for network administration;

at least a first network member and a second network member, each member including a computer comprising means for communicating over a global network;

at least a first network access device and a second network access device, wherein the first access device is accessible by the first network member and the second access device is accessible by the second network member each of the first network access device and the second network access device storing information about the corresponding one of the first network member and the second network member such that the information is searchable by the other one of the first network member and the second network member; and

for each network access device and the network authority, an interface facilitating connection to a global network.

2. The network claimed in claim 1, wherein the global network interface provides priority network transmission by connection to a commercial global network system which provides business critical levels of service.

3. A dynamic virtual network claimed in claim 1, including means for communication between the first and second network access devices, and the network authority, which utilizes digital certificates.

4. A dynamic virtual network claimed in claim 1, wherein at least the first and second network members include means for exchanging public keys.

5. A dynamic virtual network claimed in claim 1, wherein the network authority further includes a means for contemporaneously archiving a communication transmitted over the network.

6. A dynamic virtual network claimed in claim 1, wherein each network access device includes a means for contemporaneously archiving a communication transmitted through the device.

7. A dynamic virtual network claimed in claim 1, including means for enabling limited access to the member's information to other network members, while excluding non-members from access.

28. A method for forming a partnership between two dynamic virtual network members connected by a network, the method comprising:

selecting a partnership criterion by the first network member;

broadcasting the partnership criterion by the first network member to other network members;

receiving by a second network member the partnership criterion;

the second network member responding to the first network member; and

establishing a partnership relationship between the first network member and second network member.

29. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the network members are connected to the network via a network access device which denies network access to net non-members.

30. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the establishment step grants the first network member access to private data via the second network member's access drive.

31. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the establishment step grants the first network member access to private data on the second network member's shared storage area.

32. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the establishment step includes transmittal by the first network member to the second network member of authorization to access private data on the first network member's network access device.

33. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the establishment step includes transmittal by the first network member to

the second network member of authorization to access private data on the first network member's share storage area.

34. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the establishment step includes permitting access by the first network member partner to role information of the second network member partner.

35. A method for forming a partnership over the dynamic virtual network as claimed in claim 28, wherein the partnership establishment includes reciprocally permitting access by one network member partner to role information of the other network member partner.

36. A method for conducting a transaction between network members over the dynamic virtual network, the method comprising:

transmitting and contemporaneously archiving information from a first network member to a second network member; and

receiving and contemporaneously archiving the transmitted information by the second network member.

37. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein a priority network transmission is carried by a commercial global network service which provides business critical levels of service.

38. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, further comprising the steps of transmitting and contemporaneously archiving by the second network member a response to the first network member; and receiving and contemporaneously archiving by the first network member the response received.

39. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein the transmitted information is contemporaneously archived by the network authority.

40. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein the archiving control element resides in the network access device.

41. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein transmitting and contemporaneously archiving information includes transmitting and contemporaneously archiving a document whose terms are unalterable.

42. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein receiving and contemporaneously archiving the transmitted information includes sending a return receipt.

43. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, further comprising establishing a partnership between the first and second network members before the transmitting and contemporaneous archiving step.

44. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein transmitting and contemporaneously archiving includes encrypting the information.

45. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 44, wherein encrypting the transmitted information includes exchanging public keys between the first and second network members.

46. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 36, wherein receiving and contemporaneously archiving transmitted information includes digitally signing a document by the second network member.

47. A method for conducting a transaction between network members over the dynamic virtual network as claimed in claim 46, wherein receiving and contemporaneously archiving transmitted information further includes transmitting the signed document to the first network member.

51. The method of claim 28, wherein the partnership criterion is expressed as a search, and wherein the step of receiving comprises performing the search at the second network member.

IX. Evidence Appendix

No evidence is relied upon in the present appeal.

X. Related Proceedings Appendix

There are no related proceedings.